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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/274,935	03/23/1999	KATHLEEN L. COVERT	EN997064	9143

7590 04/19/2002
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EXAMINER

MARKOFF, ALEXANDER

ART UNIT	PAPER NUMBER
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1746

DATE MAILED: 04/19/2002

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/274,935

Applicant(s)

COVERT ET AL.

Examiner

Alexander Markoff

Art Unit

1746

--Th MAILING DATE of this communication appears on the cover sheet with the correspondence address--

THE REPLY FILED 03 April 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-20.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Alexander Markoff
Primary Examiner
Art Unit: 1746

09/274,935

Continuation of 5. does NOT place the application in condition for allowance because: of the reasons of the record.

The question whether or not the applicants can add a negative limitation to the claims is not relevant to the fact that the claimed invention is not patentable over the cited prior art.

It is again noted that the applicant's arguments contradict to the specification, which states that nitric acid can be used in the process of the invention (page 13, lines 9-11).

It is also noted that the applicants cited a part of the specification in support of their statement regarding the use of nitric acid. However, the cited text is not presented in the referenced part of the specification (page 4, line 9). The referenced part of the specification is directed to the use of stabilizers.

It is further noted that the examiner never suggested to use a negative limitation or a Markush language in the claims. The examiner never proposed or suggested language for the claims.

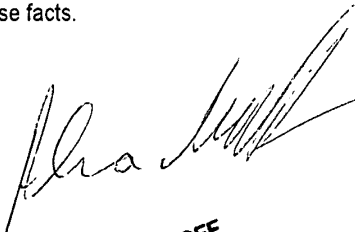
The only comment made by the examiner was that the PTO rules do not exclude the use of negative limitations, if such limitation is supported by the specification.

This comment was made merely in reply to the applicant's statement that the use of negative limitations is against the rules.

The examiner agrees with the applicants that in the instant case the use of negative limitation to exclude the use of nitric acid would not be proper because the specification explicitly teaches that nitric acid can be used.

Further, it is again noted that the applied reference teaches the use of nitric acid as one of the alternatives among other acids, such as sulfuric acid, which is recited by the claims. The prior art discloses a method comprising the same steps as the claimed method, uses the same chemicals.

A mere statement made by the applicant is not sufficient to overcome these facts.



ALEXANDER MARKOFF
PRIMARY EXAMINER